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PTO/SB/21 (01-03)

Approved for use through 04/30/2003. OMB 0651-0031

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/616,359
Filing Date	July 9, 2003
First Named Inventor	Bizzarro
Art Unit	1626
Examiner Name	Lambkin, Deborah C.
Attorney Docket Number	20400 US6

Total Number of Pages in This Submission

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Samuel H. Megerditchian
Signature	<i>Samuel H. Megerditchian</i>
Date	November 10, 2004

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on this date November 10, 2004

Typed or printed	Samuel H. Megerditchian		
Signature	<i>Samuel H. Megerditchian</i>	Date	November 10, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,359	07/09/2003	Fred Thomas Bizzarro	20400 US6	1357

151 7590 06/23/2004

HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110

EXAMINER

LAMBKIN, DEBORAH C

ART UNIT

PAPER NUMBER

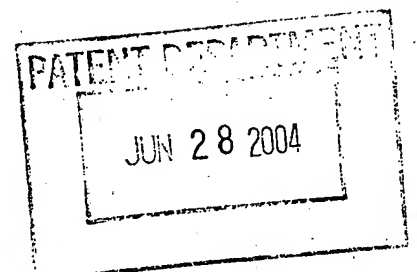
1626

DATE MAILED: 06/23/2004

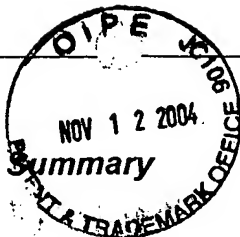
Please find below and/or attached an Office communication concerning this application or proceeding.

RESPONSE DUE: <u>September 23, 2004</u>
STATUTORY PERIOD EXPIRES: <u>December 23, 2004</u>

*bah*



**Office Action Summary**



Application No.

10/616,359

Applicant(s)

BIZZARRO ET AL.

Examiner

Deborah C Lambkin

Art Unit

1626

-- THE MAILING DATE OF THIS COMMUNICATION APPEARS ON THE COVER SHEET WITH THE CORRESPONDENCE ADDRESS --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-278 is/are pending in the application.
- 4a) Of the above claim(s) 2-278 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*DL*  
DEBORAH C. LAMBKIN  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1626

***Election/Restrictions***

Applicant's election with traverse of Group II in the reply filed on 3/8/04 is acknowledged. The traversal is on the ground(s) that it is improper to restrict intra-claim. Although not agreeing with this entirely, the present restriction requirement is hereby withdrawn and the generic claim would be examined according to MPEP 803.02 for Markush-type claims, where there is an election of species involved.

As a result, only claim 1 would be examined to a reasonable extent necessary to determine allowability; hence claims 2-278 are being temporarily held withdrawn from further consideration pending the outcome of claim 1.

***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,320,050. This is a double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah C Lambkin whose telephone number is 571-272-0698.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699.

*Deborah C Lambkin*  
DEBORAH C. LAMBKIN  
PRIMARY EXAMINER

FORM PTO-1449

U.S. Department of Commerce  
Patent and Trademark Office

Atty. Docket No. 20400US6

Serial No. 10/616,359

LIST OF INFORMATION CITED BY APPLICANT  
(Use several sheets if necessary)

Applicants: Bizzaro, et al.

Filing Date: 07/09/2000

Class: 1626

NOV 12 2004

## U.S. PATENT DOCUMENTS

* EXAMINER INITIAL	A	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
<i>du</i>	A1	3,431,301	3/4/69	Focella et al.			
<i>me</i>	A2	3,776,917	12/4/73	Mann et al.			
<i>du</i>	A3	5,556,859	9/1996	Johnson			

## FOREIGN PATENT DOCUMENTS

	B	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
<i>du</i>	B1	EP 566 138	10/20/93	Europe				
	B2	WO 00/26202	5/11/00	World (PCT)				
	B3	1,436,502	5/19/76	Spain				
	B4	DE 249 241	07/13/12	Germany				

## OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

<i>du</i>	C1	Rodier et al., Acta Crystallogr., C46, pg. 154-156 (1990)
	C2	Robert et al., Eur. J. Med. Chem., Vol. 29, pgs. 841-854 (1994)
	C3	Spickett et al., Eur. J. Med. Chem. -Chimica Therapeutica, Vol. 11(1), pgs. 7-12 (1976)
	C4	Bhat et al., Inst. Chemists (India), Vol. 61, pgs. 134-136 (1989)
<i>✓</i>	C5	Spielman, M.A., et. al. J. Am. Chem. Soc., 70, pp. 4189-4191 (1948)

EXAMINER

*D. Lambher*

DATE CONSIDERED

*6/7/04*

\*EXAMINER Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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